



Docket No. 4562C1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SHIN et al.

Serial No.: 10/642,418

Filed: August 14, 2003

For: **APPARATUS AND METHOD FOR  
EJECTING SAMPLE WELL TRAYS**

) Group Art Unit: 1744  
)  
)

) Examiner: David A. Redding  
)  
)

**CERTIFICATE OF MAILING**

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**INFORMATION DISCLOSURE STATEMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants submit herewith patents, publications or other information (listed on the attached Form PTO/SB/08A) of which they are aware, which may be material to the examination of this application and in respect of which there may be a duty to disclose in accordance with 37 CFR §1.56.

This Information Disclosure Statement:

- (a) ☐ accompanies a new patent application submitted herewith.
- (b) ☐ is filed within three months after the filing date of the application or within three months after the date of entry of the national stage of a PCT application as set forth in 37 CFR §1.491.
- (c) ☐ as far as is known to the undersigned, is filed before the mailing date of a first Office action on the merits.

- (d) ☒ as far as is known to the undersigned, is filed before the mailing date of a first Office action upon the filing of a request for continued examination under § 1.114.
- (e) ☐ is filed after the first Office Action and more than three months after the application's filing date or PCT national stage date of entry filing but, as far as is known to the undersigned, prior to the mailing date of either a final action under §1.113, a notice of allowance under §1.311, whichever occurs first, and is accompanied by either the fee (\$180) set forth in 37 CFR §1.17(p) or a certification as specified in 37 CFR §1.97(e), as checked below. Should any fee be due, the U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 01-2213 in the amount of \$180.00 to cover the cost of this Information Disclosure Statement. Any deficiency or overpayment should be charged or credited to this deposit account. **A duplicate of this sheet is enclosed.**
- (f) ☐ is filed after the mailing date of either a final rejection or a notice of allowance, but on or before the payment of the issue fee, and is accompanied by the fee (\$180) set forth in 37 CFR §1.17(i)(1) **and** a certification as specified in 37 CFR §1.97(e), as checked below. **This document is to be considered as a petition requesting consideration of the information disclosure statement.** The U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 01-2213 in the amount of \$180.00 to cover the cost of this Information Disclosure Statement. Any deficiency or overpayment should be charged or credited to this deposit account. **A duplicate of this sheet is enclosed.**

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- ☐ Each item of information contained in the information disclosure statement was first cited in a communication mailed from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication mailed from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this information disclosure statement.

A copy of the items on PTO/SB/08A that are not United States Publications:

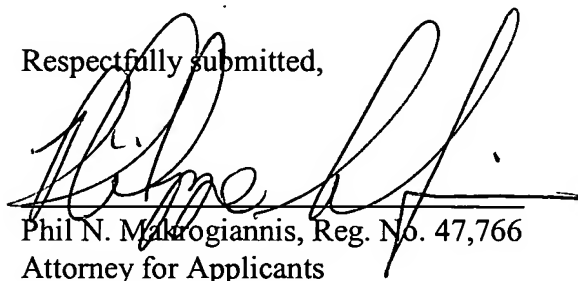
- ☐ are supplied herewith.

[X] are not supplied because they were previously cited by or submitted to the Office in prior application Serial No. 09/496,408, filed February 2, 2000 and relied upon in this application for an earlier filing date under 35 USC §120.

While the information and references disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR §1.56, it is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR §1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR §1.56(a) exists. It is submitted that the Information Disclosure Statement is in compliance with 37 CFR §1.98 and MPEP §609 and the Examiner is respectfully requested to consider the listed references.

Respectfully submitted,



Phil N. Makrogiannis, Reg. No. 47,766  
Attorney for Applicants

Date: November 9, 2004

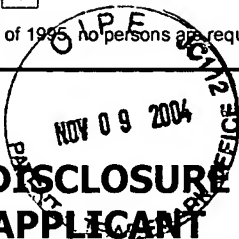
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## INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet 1 of 3

### Complete if Known

Application Number	10/642,418
Filing Date	August 14, 2003
First Named Inventor	Hon Siu Shin et al.
Group Art Unit	1744
Examiner Name	David A. Redding
Attorney Docket No.	4562C1

### U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code <sup>2</sup> (if known)			
	1	3,634,651		Siegell et al.	01-11-1972	
	2	4,094,641		Friswell	06-13-1978	
	3	4,096,965		Lessnig et al.	06-27-1978	
	4	4,909,992		Björkman	03-20-1990	
	5	5,030,418		Miyata	07-09-1991	
	6	5,159,197		Wannlund	10-27-1992	
	7	5,282,543		Picozza et al.	02-01-1994	
	8	5,346,672		Stapleton et al.	09-13-1994	
	9	5,378,433		Duckett et al.	01-13-1995	
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	11	5,582,665		Eigen et al.	12-10-1996	
	12	5,604,130		Warner et al.	02-18-1997	
	13	5,681,492		Van Praet	10-28-1997	
	14	5,721,136		Finney et al.	02-24-1998	
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	17	6,251,662		Day	06-26-2001	
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	21	6,555,792		Elsener et al.	04-29-2003	
	22	6,638,761		Shin et al.	10-28-2003	

### FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	23	DE	195 01 298	C1		02-08-1996		X
	24	EP	0 379 437	B1		07-25-1990		
	25	EP	0 542 422	A1		05-19-1993		
	26	EP	0 606 534	B1		07-20-1994		
	27	EP	0 810 030	A1		12-03-1997		
	28	EP	0 810 030	B1		12-03-1997		
	29	EP	0 836 884	A2		04-22-1998		X

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<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

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				<b>Application Number</b>	10/642,418
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				<b>First Named Inventor</b>	Hon Siu Shin et al.
				<b>Group Art Unit</b>	1744
				<b>Examiner Name</b>	David A. Redding
				<b>Attorney Docket No.</b>	4562C1
<b>Sheet</b>	2	of	3		

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	30	GB	1 427 034			03-03-1976	
	31	WO	90/08298			07-26-1990	
	32	WO	98/42442			10-01-1998	
	33	WO	98/56506			12-17-1998	
	34	WO	99/17881			04-15-1999	
	35	WO	99/20395			04-29-1999	

OTHER ART - NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	36	D.C. UBER et al., "Application of Robotics and Image Processing to Automated Colony Picking and Arraying," <i>BioTechniques</i> , Vol. 11, No. 5, 642-644 (1991).	
	37	PETER JONES et al., "Integration of Image Analysis and Robotics into a Fully Automated Colony Picking and Plate Handling System," <i>Nucleic Acids Research</i> , Vol. 20, No. 17, 4599-4606 (1992).	
	38	Translation of DE 197 39 119 A1.	X
	39	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Notice Declaring Interference," Paper no. 1, dated Aug. 13, 2003.	
	40	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Interference Initial Memorandum," attached to Aug. 13, 2003 Notice Declaring Interference, Paper no. 1.	
	41	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Shin List of Intended Preliminary Motions Under 37 CFR § 1.633," dated Sept. 2003.	
	42	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Elsener List of Intended Preliminary Motions," dated Sept. 29, 2003.	
	43	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Order Setting Times," Paper no. 18, dated Oct. 2, 2003.	

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<b>Sheet</b>	3	of	3	<b>Attorney Docket No.</b>	4562C1

44	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Order," Paper no. 19, dated Oct. 7, 2003.	
45	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Summary of Telephone Conference," Paper no. 22, dated Oct. 28, 2003.	
46	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Shin Stipulation to Level of Ordinary Skill in the Art," dated Nov. 14, 2003.	
47	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Summary of Telephone Conference," Paper no. 24, dated Nov. 18, 2003.	
48	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Shin Revised Stipulation to Level of Ordinary Skill in the Art," dated Nov. 25, 2003.	
49	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Senior Party Notification of Change of Ownership of the Elsenner Patent and Request for Termination of the Interference Proceedings Under CFR § 1.602," dated June 10, 2004.	
50	ELSENER et al. v. SHIN et al., Patent Interference No. 105,141, "Judgment - Rule 602," Paper no. 40, dated July 20, 2004.	
51	Opposition to EP 1 088 590 B1 (European Patent Application no. 00 810 855.7), filed Jan. 16, 2003 at EPO on behalf of AB Applied Biosystems, An Applera Corporation.	
52	Opposition to EP 1 088 590 B1 (European Patent Application no. 00 810 855.7), Decision on the Termination of the Opposition Proceedings, Issued June 30, 2004, along with English translation.	X

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